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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,923	04/26/2000	John Albert Kembel	10351-0006	1656

7590 10/20/2004

INNOVATION MANAGEMENT SCIENCES
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EXAMINER

NGUYEN, CHAU T

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/558,923	KEMBEL ET AL.	
	Examiner	Art Unit	
	Chau Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/23/2004 has been entered. Claims 1-24 are canceled, and claims 25-38 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a

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nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 25-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-31 of copending Application No. 09/558,922. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is similar to the context of the cited claims of the Application No. 09/558/922.

Application No. 09/558,922 discloses a method of providing Internet content to a user of a computing device including providing a client user interface separate from a conventional web browser, the client user interface operable to display Internet content within a frame defined at least in part by the client user interface, wherein the frame of the client user interface is separate from a frame of the conventional web browser and displaying first Internet content through the frame defined at least in part by the client user interface. It would have been obvious to take an action to provide a display menu of user selectable items so

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the user can select items of interests and server can locate and send interested items to the user.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan, US Patent No. 5,761,662 and further in view of Furst, US Patent No. 6,297,819.

6. As to claims 25 and 32, Dasan discloses a method of co-ordinating delivery of Internet content to a user of a computing device, comprising:

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providing a client user interface, the client user interface operable to display Internet content within a frame defined at least in part by the client user interface, (col. 3, line 55 – col. 4, line 50 and col. 7, lines 22-41);

displaying a menu of user selectable items, wherein at least one of the items corresponds to Internet content (col. 7, lines 22-41);

in response to a user selection of the at least one item, displaying corresponding Internet content through a first frame defined at least in part by the user interface (col. 7, line 42 – col. 8, line 21).

Dasan discloses the user selects topic of interest, such as by filling in the field provided by the fill-in forms feature of HTML or CGI (Common Gateway Interface), which is considered to separate from a web browser (col. 7, lines 22-60). However, in order to show a clear picture of an interface that separates from a conventional web browser, Furst discloses a system that provides browser extensions that are based on server processes, and the system includes a core of functionality to which can be added user-selectable component application tools (user interface) that runs on the user's computer and interacts with the user's running web browser (Furst, col. 1, line 55 – col. 2, line 31 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Furst and Dasan to interpret that the component application tools (user interface) separate from that of a conventional web browser and wherein the frame of the client user interface is separate from a frame of the conventional web browser. Furst suggests that the

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system enhances the user's web surfing experience for entertainment, community-building, transaction support, and knowledge acquisition.

7. As to claims 26 and 33, Dasan and Furst disclose in response to a user selection of another one of the user selectable items, displaying Internet content corresponding to the other user selectable item through a second frame defined at least in part by the client user interface (Dasan, col. 8, lines 22-40).

8. As to claims 27 and 34, Dasan and Furst disclose transmitting a request corresponding to the user selection to a server (Dasan, col. 3, lines 30-46).

9. As to claims 28 and 35, Dasan and Furst disclose receiving an address of the corresponding Internet content (Dasan, col. 6, lines 20-37).

10. As to claims 29 and 36, Dasan and Furst disclose retrieving the corresponding Internet content at the received address (Dasan, col. 6, lines 20-37).

11. As to claims 30 and 37, Dasan and Furst disclose wherein the corresponding Internet content comprises content renderable by the conventional web browser program (Furst, col. 3, lines 15-22: Furst's system enhances the user's web surfing experience for entertainment, community-building, transaction support, and knowledge acquisition).

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12. As to claims 31 and 38, Dasan and Furst disclose wherein the client user interface operable to display Internet content that is renderable by the conventional web browser (Furst, col. 3, lines 15-22: Furst's system enhances the user's web surfing experience for entertainment, community-building, transaction support, and knowledge acquisition).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The Examiner's future phone number is (571) 272-4092, which will be effective sometime in October 2004. The Examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (703) 305-9792.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176


JOSEPH H. FEILD
PATENT EXAMINER